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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/516,694	12/02/2004	Robert Mostowski	849-007	5302
39600	7590	08/23/2006		
SOFER & HAROUN LLP. 317 MADISON AVENUE, SUITE 910 NEW YORK, NY 10017			EXAMINER BALDWIN, GORDON	
			ART UNIT 1775	PAPER NUMBER

DATE MAILED: 08/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/516,694

Applicant(s)

MOSTOWSKI, ROBERT

Examiner

Gordon R. Baldwin

Art Unit

1775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

**Claims 1, 2 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Pat. No. 4,224,364 (Hunt).**

**Consider claim 1**, Hunt teaches a glass ornament (Col. 4 lines 3-5) with two different modules or housing sections (11) and (12) that can be hollow, shell-like or any shape (Col. 1, lines 60-66) and are connected by a connector ring (13), which form a plane between both housing sections in figure (9). (Col. 3 lines 62-67 and Col. 4 lines 1-2) Additionally, “blown” is considered a process limitation and does not distinguish over the structure of the prior art.

**Consider claim 2**, Hunt teaches that both housing sections (11 & 12) are to be frictionally fit against the flanges of the ring (13), and are to be releasably retained. Since both housing sections are secured on the rim, the rim is considered to have two locks, that makes one lock on either side of the ring (13) which retain both housing sections. (Col. 2 lines 19-23)

**Consider claim 10**, Hunt teaches that items may be placed inside the ornament. (Col. 2 lines 40-44)

**Claims 1 are rejected under 35 U.S.C. 102(b) as being anticipated by Pat. No. 1,956,161 (Smith)**

**Consider claim 1**, Smith teaches the making of solid blown glass decoration in the shape of a canteen globe (Col. 1 lines 1-4) or roughly shell-like that is separated into two shell-like sections with a joint (fig. 12) securing the two sections together.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 3,4, 5,6,7,8,9, 11 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pat. No. 1,956,161 (Smith) in view of <http://www.faberge.de/relaunch/index.html> (The Elephant Egg).**

**Consider claim 3**, Smith teaches claim 1, but Smith does not teach that the first and second modules are connected by an articulating joint and are closed by one lock on the rim of each module. Faberge(<http://www.faberge.de/relaunch/index.html>) teaches the use of the first module having an articulating joint to connect the two modules with a lock as a closing means on the top part of the rib of the module. It would have been obvious to one of ordinary skill in the art at the time of invention to combine the glass modules of Smith with the articulating joints and locks of Faberge to

be able to have access to the inner portion of the modules to have a greater area to decorate the modules.

Conversely, it would have been obvious to one of ordinary skill in the art at the time of the invention to make the Faberge Elephant Egg out of glass, as Smith clearly teaches that it is known to form a globe with multiple pieces made of blown glass which are hinged together and are provided with etching and/or paint for decoration thereof.

**Consider claim 4**, Smith teaches that the globe is initially formed of one piece with specific structural faults that allow the two portions (first module and second module) to be separated by breaking the glass in the designed weak points. (Col. 1, lines 38-50)

**Consider claim 5**, Faberge, specifically with the Elephant Egg, teaches that the top module of the egg has two body portions that are joined to the lower module with the use of a articulated hinge with the two upper bodies being able to clasp together through the use of a latch and place the two “spatial” bodies and the lower module on a common plane.

**Consider claim 6**, Faberge teaches the use of gold for the metal in its rims along with the articulating joints for connecting the modules.

**Consider claim 7**, Faberge teaches a projection that can be used for suspending a hanger.

**Consider claim 8**, Faberge teaches the spatial bodies as stated in the rejection of claim five (5) along with a projection in the top part of the body which can have a variety of items affixed to it, including lace or a lace hanger.

**Consider claim 9**, Faberge teaches the use of a second bottom module in the oval shape of an egg, constituting a shell construction, with a flat surface upon which an ornament or decoration is placed.

**Consider claim 11**, Faberge teaches that the outer surface of the ornament is treated with enamel and white opals and jewels. Additionally, "obtained from a metal mould" is considered a process limitation and does not distinguish over the structure of the prior art.

**Consider claim 12**, Faberge teaches a roof in which a miniature object is placed inside the modules.

### ***Response to Arguments***

Applicant has overcome the 112 rejections of claims 1, 6, 8, 9 and 11.

Applicant's rejection under 35 U.S.C. 101 is withdrawn due to the amendments of the claims of application number 11009960.

Applicant's arguments, in regard to the U.S.C. 102 & 103 rejections, filed 6/15/2006 have been fully considered but they are not persuasive.

The applicant argues that the arrangement of the invention is made new and novel by the two correlated modules being constructed of thin-walled blown glass. While the argument is understood, the use of blown glass over the use of a manufactured or machine made glass is not shown to be capable of anything patentably distinct (such as a particular function or physically distinct) and therefore is not considered to provide a novel or non-obvious distinction over the prior art. A

manufactured glass can be made very thin and be cut into to two modules to form an ornament. (Hunt '364)

As the applicant points out, Hunt '364 advocates the use of LEXAN in the making of the ornament. However, in that same paragraph, column 4 lines 3-5, Hunt indicates that glass can be used to make the desired ornament. The glass that Hunt mentions, as a possible material for the modules of the ornament, is considered structurally or materially identical to the mouth blown glass and is therefore not accorded distinct or novel status.

Additionally, the applicant applies the same arguments regarding the material used (blown glass versus manufactured or machine-made glass) in the U.S.C. 103 (a) rejection with Smith and Faberge. While the arguments were considered, any distinctions between the glass or glass crystal of Smith or Faberge are not considered patentably distinct and therefore do not traverse the rejection.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gordon R. Baldwin whose telephone number is (571)272-5166. The examiner can normally be reached on M-F 7:45-5:15.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jennifer McNeil can be reached on 571-272-1540. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

GRB



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SUPERVISORY PATENT EXAMINER  
8/14/06